

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Examiner: Christopher T. Schatz
Group Art Unit: 1791

In re Application of: Eddy Boucke

Serial No: 10/525,282

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For: Method of Manufacturing a Floor
Panel

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/Susan Vanderwalker/
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APPEAL BRIEF

Mail Stop APPEAL BRIEF – PATENTS
Commissioner of Patents and Trademarks
Alexandria, VA 22313-1450

Dear Commissioner:

Appellants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decisions of the Examiner of Groups Art Unit 1791 dated March 4, 2009, rejecting Claims 1-25. A Notice of Appeal for this case was filed on August 4, 2009.

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I. REAL PARTY IN INTEREST

The real party in interest is Berry Finance NV, the assignee of the patent application at issue. Berry Finance NV is a Belgian corporation, headquartered in Oostrozebeke, Belgium.

II. RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences with regard to the present application.

III. STATUS OF CLAIMS

Claims 1-25 are pending in this case. Claim 10 was withdrawn and claims 1-9 and 11-25 were rejected. The Appellants are appealing the rejection of claims 1-9 and 11-25. See Appendix A for a listing of claims as currently pending in this case.

IV. STATUS OF AMENDMENTS

No amendments were made after the office action of March 4, 2009.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present application relates to a method of manufacturing a floor panel with a beveled edge, which results in a floor panel that shows no interruption in the surface layer. [See p. 1, first paragraph, through p. 2, second full paragraph].

A first method is described in claim 1 for manufacturing a floor panel (2). The method comprises the following steps:

- providing a panel body (12) having a core (3, 13) a top side (3a, 13a) of said core (3, 13) being provided with a top surface layer (4), said panel body (12) further having a side surface (13b) extending transversely to the top surface layer (4). [See p. 6, last paragraph, through p. 7, first paragraph; Fig. 3].

- forming a recess (15) extending under the top surface layer (4) from the side surface (13b) into the panel body (12) by leaving a freestanding ledge (16) including said top surface layer (4), said recess (15) having opposing first and second recess surfaces (15a, 15b) and being open at the side surface (13b). [See p. 7, second paragraph, through the paragraph bridging pp. 7 and 8; Fig. 4].

- closing said recess (15) by fixing the first and second recess surfaces (15a, 15b) to one another, thereby forming a floor panel (2) having a beveled top edge (10a, 10b, 25, 26) with the top surface layer (4) extending continuously and in one piece from the top side (3a, 13a) of the core (3, 13) over the beveled top edge (10a, 10b, 25, 26). [See p. 8, first full paragraph; Fig. 5].

A second method is described in claim 11 for manufacturing a floor panel (2). The method comprises the following steps:

- providing a panel body (12) having a core (3, 13), a top side (3a, 13a) of said core (3, 13) being provided with a top surface layer (4), said panel body (12) further having a side surface (13b) extending transversely to the top surface layer (4). [See p. 6, last paragraph, through p. 7, first paragraph; Fig. 3].

- forming a recess (15) extending under the top surface layer (4) from the side surface (13b) into the panel body (12) by leaving a freestanding ledge (16) including said top surface layer (4), said recess (15) having at least two opposing recess surfaces (15a, 15b). [See p. 7, second paragraph, through the paragraph bridging pp. 7 and 8; Fig. 4].

- closing said recess (15) by fixing the at least two opposing recess surfaces (15a, 15b) to one another, thereby forming a floor panel (2) having a beveled top edge (10a, 10b, 25, 26) with the top surface layer (4) extending continuously and in one piece from the top side (3a, 13a) of the core (3, 13) over the beveled top edge (10a, 10b, 25, 26). [See p. 8, first full paragraph; Fig. 5].

A third method is described in claim 20 for manufacturing a floor panel (2). The method comprises the following steps:

- providing a panel body (12) having a core (3, 13), a top side (3a, 13a) of said core (3, 13) being provided with a top surface layer (4), said panel body (12) further having a side surface (13b) extending transversely to the top surface layer (4). [See p. 6, last paragraph, through p. 7, first paragraph; Fig. 3].

- forming a recess (15) extending under the top surface layer (4) from the side surface (13b) into the panel body (12) by leaving a freestanding ledge (16) including said top surface layer (4), said recess (15) having at least two opposing recess surfaces (15a,

15b) and being open only at said side surface (13b). [See p. 7, second paragraph, through the paragraph bridging pp. 7 and 8; Fig. 4].

- closing said recess (15) by fixing the at least two opposing recess surfaces (15a, 15b) to one another by applying adhesives and applying pressure to said ledge (16), thereby forming a floor panel having a beveled top edge (10a, 10b, 25, 26) with the top surface layer (4) extending continuously and in one piece from the top side (3a, 13a) of the core (3, 13) over the beveled top edge (10a, 10b, 25, 26). [See p. 8, first full paragraph; Fig. 5].

- removing material from said side surface (13b) adjacent to said recess (15) to provide a flushing side surface after having closed said recess (15). [See p. 8, second full paragraph, and paragraph bridging pp. 8 and 9; compare Fig. 5 with Figs. 1 and 2].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether claims 1-8 and 11-18 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2003/0159385 (“Thiers”) in view of U.S. Patent No. 4,348,448 (“Cornell”) and U.S. Patent No. 4,008,551 (“MacDonald”).
- B. Whether claims 9 and 19-25 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2003/0159385 (“Thiers”) in view of U.S. Patent No. 4,348,448 (“Cornell”) and U.S. Patent No. 4,008,551 (“MacDonald”), and further in view of U.S. Patent No. 4,704,834 (“Turner”).

VII. ARGUMENT

A. Thiers, Cornell, and McDonald, neither individually nor in combination, disclose all limitations of claims 1-8 and 11-18.

1. **None of the prior art methods result in a recessed side surface and a free-standing ledge including the top surface layer.**

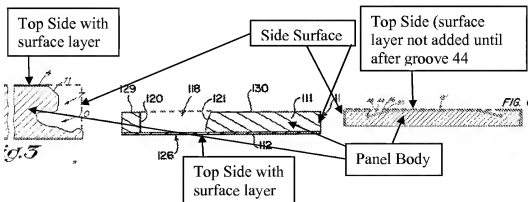
The claims as drafted do not read on the prior art cited by the Examiner, either alone or in combination. More specifically, none of the methods disclosed by Thiers, Cornell, and MacDonald results in a recessed side surface and a free-standing ledge including the top surface layer left after having formed the recess.

The first step of the independent claims 1, 11, and 20 call for the providing of “a panel body having a core, a top side of said core being provided with a top surface layer, said panel body further having a side surface extending transversely to the top surface layer.” The elements recited in this limitation correspond with Thiers, Cornell, and MacDonald as follows (modified to reflect configuration prior to milling/cutting):

Thiers, Fig. 3

Cornell, Fig. 5

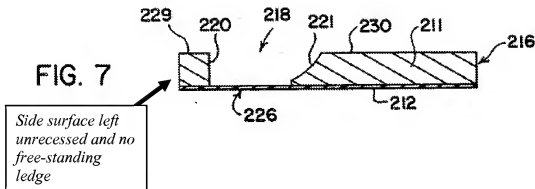
McDonald, Fig. 6



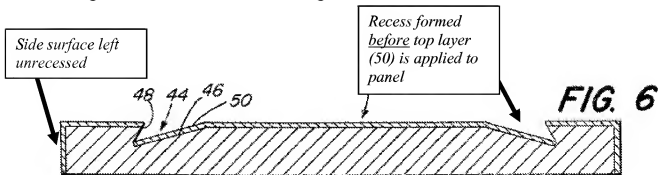
The second step of the independent claims 1, 11, and 20 call for a formation of “a recess extending under the top surface layer from the side surface into the panel body by

leaving a freestanding ledge including the top surface layer. None of the references cited by the examiner, even in combination, disclose or suggest this operation.

Cornell forms its recess from the bottom side – the side opposite the top surface – and leaves the side surface unrecessed. No free-standing ledge is formed using the method taught by Cornell. See, for example, Figure 7 of Cornell:



MacDonald also does not form its recess from the side surface, but instead forms its recess from the top surface. Moreover, MacDonald discloses a method of first forming a recess in a panel body from the top surface and thereafter covering the top surface, the recess and the necessary side surfaces with a surface layer. This is contrary to the claimed methods, which require as a first step "providing a panel body have a core, a top side of said core being provided with a top surface layer . . ." and as a second step "forming a recess . . ." See MacDonald Figure 6 below:



At the time of forming the recess shown in MacDonald Figure 6, the top surface layer (i.e. strip 50 of plastic veneer) is not present on the panel. *See* MacDonald at col. 3, line 60 – col. 4, line 2. MacDonald teaches to attach the strip 50 of plastic veneer only after the recess is formed. MacDonald, like Cornell, therefore also does not disclose forming a recess from a side surface or leaving a freestanding ledge after the recess is formed.

Like McDonal and Cornell, Thiers does not disclose forming a recess under the top surface layer, or leaving a freestanding ledge. Indeed, it is clear from Thiers figure 10 that the top surface layer 4 on Thiers panel does not extend over and on top of the beveled edge 11, and instead that a separate “print layer” is applied to the bevel using glue or a heated pressing roll (see also Thiers para. 0052):

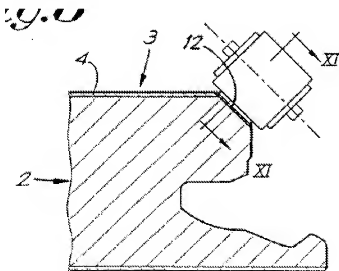
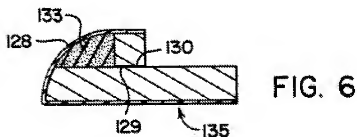
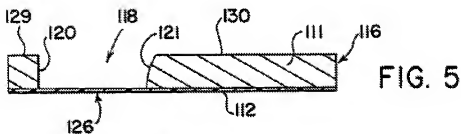


Fig. 10

As explained above, none of the references, viewed in isolation or in combination, disclose forming a recess “from a side surface” and under a top surface layer with the effect of leaving “a freestanding ledge” which includes the top surface layer.

2. There is no motivation to combine Thiers with Cornell.

Thiers and Cornell are incompatible references that cannot be combined. Thiers discloses floor coverings comprising floor panels that are designed to mechanically lock at their edges. Cornell describes notching panels from the lower side, and folding the panel about the notch to create a curvilinear side surface, as reflected in Cornell Figures 5-6 below (see also Cornell at col. 1, lines 5-20):



Having a smooth curvilinear edge is appropriate for the application of Cornell, which is to create decorative (non-functional) edges for tables, cabinetry, countertops, or the like. See Cornell at col. 1, lines 20-25. In contrast, Thiers describes panels that have specialized mechanical profiles on their edges which are designed to lock together to form a flooring, as reflected in Figures 7-8:

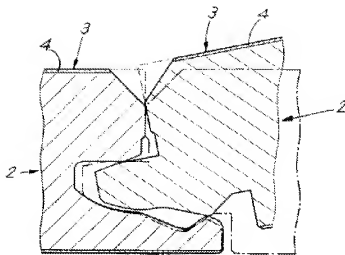


Fig. 7

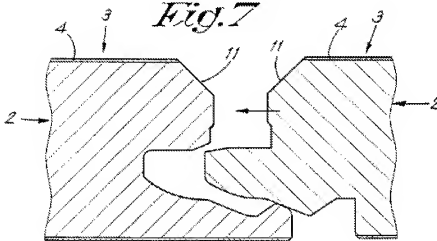


Fig. 8

This method disclosed by Cornell, which results in a smooth curvilinear side surface, simply would not work for flooring panels, which are required to have locking elements on the side edges. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification).

3. MacDonald and Thiers teach away from the claimed inventions.

The claimed methods clearly require as a first step "providing a panel body having a core, a top side of said core being provided with a top surface layer . . ." and as a second step "forming a recess . . ." The claimed method is contrary to the teachings of both McDonald and Thiers, which perform the "forming step" before applying the "top surface layer."

As explained in more detail above, McDonald discloses a method of first forming a recess in a panel body from the top surface and thereafter covering the top surface, the recess and the necessary side surfaces with a surface layer. *See* MacDonald at col. 3, line 60 – col. 4, line 2. Likewise, Thiers teaches the formation of a beveled edge on a panel, followed by the application for a print layer onto the beveled edge.

In view of the above, McDonald and Thiers clearly teach away from the claimed methods and are not properly relied upon by the Examiner. *See* Thiers, Figure 10 and para. 0052.

B. Thiers, Cornell, McDonald, and Turner, neither individually nor in combination, disclose all limitations of claims 9 and 19-25.

1. None of the prior art methods result in a recessed side surface and a free-standing ledge including the top surface layer.

See arguments above relative to claims 1-8 and 11-18, which apply equally to claims 9 and 19-25.

2. There is no motivation to combine Thiers with Cornell.

See arguments above relative to claims 1-8 and 11-18, which apply equally to claims 9 and 19-25.

3. MacDonald, Thiers, and Turner teach away from the claimed inventions.

See arguments above relative to MacDonald, Thiers, and claims 1-8 and 11-18, which apply equally to claims 9 and 19-25.

Like McDonald and Thiers, Turner teaches the application of a surface layer only after the contours of the door are formed or constructed. See Turner col. 3, lines 4-13.

4. Turner discloses trimming off excess veneer, while the present invention involves the removal of side surface material

The Examiner relies upon Turner for its disclosure of trimming off excess veneer overlay. However, the claims of the present application call for trimming off excess side surface material, not excess veneer. Because the surface layers are attached prior to milling, and because of the geometries involved, performing the claimed method does not result in excess veneer. In fact, the effect is quite the opposite. Excess side material is present. *See e.g.* Figure 5 of the present application:

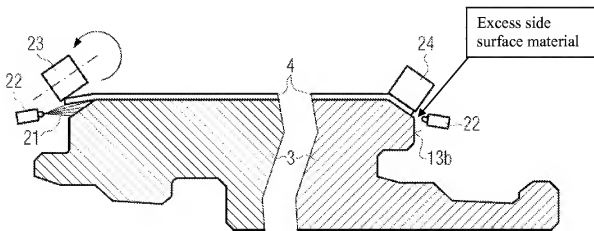


FIG. 5

CONCLUSION

For the reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is respectfully requested.

Monday, January 04, 2010

Respectfully,

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VIII. CLAIMS APPENDIX

Claim 1. (previously amended): A method of manufacturing a floor panel, the method comprising the steps of:

- providing a panel body having a core, a top side of said core being provided with a top surface layer, said panel body further having a side surface extending transversely to the top surface layer;
- forming a recess extending under the top surface layer from the side surface into the panel body by leaving a freestanding ledge including said top surface layer, said recess having opposing first and second recess surfaces and being open at the side surface; and
- closing said recess by fixing the first and second recess surfaces to one another, thereby forming a floor panel having a beveled top edge with the top surface layer extending continuously and in one piece from the top side of the core over the beveled top edge.

Claim 2. (previously amended): The method of claim 1 wherein said recess is wedge-shaped.

Claim 3. (previously amended): The method of claim 1 wherein said first recess surface is arranged adjacent to and essentially parallel to said top surface layer.

Claim 4. (previously amended): The method of claim 1 wherein said first and second recess surfaces are plain.

Claim 5. (previously amended): The method of claim 1, wherein the step of closing said recess includes the step of applying adhesive.

Claim 6. (previously amended): The method of claim 1, wherein the step of closing said recess includes the step of applying pressure to said ledge.

Claim 7. (previously amended): The method of claim 1, wherein said ledge consists essentially of said top surface layer.

Claim 8. (previously amended): The method of claim 1 wherein said floor panel includes a joining element for connecting to a further joining element of an adjacent floor panel in a floor covering formed by said floor panels, and the step of forming said recess includes the step of simultaneously forming said joining element.

Claim 9. (previously amended): The method of claim 1 wherein the step of forming said recess includes the step of removing material from said side surface adjacent to said recess to provide a flushing side surface after having closed said recess.

Claim 10. (withdrawn): A floor panel as manufactured by the method of claim 1.

Claim 11. (original): A method of manufacturing a floor panel, the method comprising the steps of:

- providing a panel body having a core, a top side of said core being provided with a top surface layer, said panel body further having a side surface extending transversely to the top surface layer;
- forming a recess extending under the top surface layer from the side surface into the panel body by leaving a freestanding ledge including said top surface layer, said recess having at least two opposing recess surfaces; and
- closing said recess by fixing the at least two opposing recess surfaces to one another, thereby forming a floor panel having a beveled top edge with the top surface

layer extending continuously and in one piece from the top side of the core over the beveled top edge.

Claim 12. (original): The method of claim 11 wherein said recess is wedge-shaped.

Claim 13. (original): The method of claim 11 wherein one of the at least two opposing recess surfaces is arranged adjacent to and essentially parallel to said top surface layer.

Claim 14. (original): The method of claim 13 wherein the at least two opposing recess surfaces are plain.

Claim 15. (original): The method of claim 11, wherein the step of closing said recess includes the step of applying adhesive.

Claim 16. (original): The method of claim 15, wherein the step of closing said recess includes the step of applying pressure to said ledge.

Claim 17. (original): The method of claim 16, wherein said ledge consists essentially of said top surface layer.

Claim 18. (original): The method of claim 16 wherein said floor panel includes a joining element for connecting to a further joining element of an adjacent floor panel in a floor covering formed by said floor panels, and the step of forming said recess includes the step of simultaneously forming said joining element.

Claim 19. (original): The method of claim 18 wherein the step of forming said recess includes the step of removing material from said side surface adjacent to said recess to provide a flushing side surface after having closed said recess.

Claim 20. (previously amended): A method of manufacturing a floor panel, the method comprising the steps of:

- providing a panel body having a core, a top side of said core being provided with a top surface layer, said panel body further having a side surface extending transversely to the top surface layer;
- forming a recess extending under the top surface layer from the side surface into the panel body by leaving a freestanding ledge including said top surface layer, said recess having at least two opposing recess surfaces and being open only at said side surface;
- closing said recess by fixing the at least two opposing recess surfaces to one another by applying adhesives and applying pressure to said ledge, thereby forming a floor panel having a beveled top edge with the top surface layer extending continuously and in one piece from the top side of the core over the beveled top edge; and,
- removing material from said side surface adjacent to said recess to provide a flushing side surface after having closed said recess.

Claim 21. (original): The method of claim 20 wherein said recess is wedge-shaped.

Claim 22. (original): The method of claim 21 wherein one of the at least two opposing recess surfaces is arranged adjacent to and essentially parallel to said top surface layer.

Claim 23. (original): The method of claim 22 wherein the at least two opposing recess surfaces are plain.

Claim 24. (original): The method of claim 23, wherein said ledge consists essentially of said top surface layer.

Claim 25. (original): The method of claim 24 wherein said floor panel includes a joining element for connecting to a further joining element of an adjacent floor panel in a floor covering formed by said floor panels, and the step of forming said recess includes the step of simultaneously forming said joining element.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.